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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,926	01/09/2007	Klaus Klinkenberg	DE 040102	4706

24737 7590 03/03/2009
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
PERRY, ANTHONY T	

ART UNIT	PAPER NUMBER
2879	

MAIL DATE	DELIVERY MODE
03/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/572,926	KLINKENBERG ET AL.	
	Examiner	Art Unit	
	ANTHONY T. PERRY	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☒ Claim(s) *4 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claim 4 is objected to because of the following informalities: in line 3, replace "fibres" with --fibers--. Appropriate correction is required.

Claim 8 is objected to because of the following informalities: in line 5, replace "0 , 5" with --0.5-- and in line 6, replace "0 , 05" with --0.05--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 4 recites the broad recitation a filter comprising glass fibers, and the claim also recites "preferably a HEPA-filter" which is the narrower statement of the limitation.

Also, claim 8 recites the broad range of ≤ 2 seconds, and the claim also recites "more preferably ≤ 1 seconds", "more preferably ≤ 0.5 seconds", and "most preferred ≤ 0.05 seconds" which are the narrower statements of the range.

Claim 4 contains the trademark/trade name HEPA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a type of filter and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawashima (JP 2002-333670).

Regarding claim 1, Kawashima teaches a lighting device comprising a lamp comprising a burner with an ionizable filling and an amount of mercury contained therein, having at least one mercury absorbing/adsorbing and/or blocking means located outside the burner for the fixation of mercury in case of an explosion of the burner (for example, see paragraphs 0021-0031).

Regarding claim 2, Kawashima teaches the lighting device according to claim 1, comprising a mercury blocking means (for example, see 0021-0024).

Regarding claim 3, Kawashima teaches the lighting device according to claim 1, wherein the mercury blocking means is a filter means (for example, see paragraph 0024).

Regarding claim 4, Kawashima teaches the lighting device according to claim 1, wherein the mercury blocking means is a filter comprising glass fibers (for example, see paragraph 0031).

Regarding claim 5, Kawashima teaches the lighting device according to claim 1, comprising a mercury absorbing/adsorbing means (for example, see paragraphs 0028-0031).

Regarding claim 6, Kawashima teaches the lighting device according to claim 1. It is noted that claim 6 is dependent from claim 1, which states that the device includes at least one mercury absorbing/adsorbing **and/or** blocking means. Since Kawashima at least teaches the mercury absorbing means, it does not matter if it does not specifically disclose a mercury absorbing/adsorbing means selected from active carbon, aluminum oxide, zeolithes, almalgam forming compounds, monolithic catalysts and mixtures thereof, since a mercury blocking means

is not required by the claim due to the use of "and/or" in independent claim 1, from which claim 6 depends.

Regarding claim 7, Kawashima teaches the lighting device according to claim 1. In regards to the recitation "capable of fixing $\geq$ 20% of the mercury contained in the burner", it has been held that the recitation of an element being capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 8, Kawashima teaches the lighting device according to claim 1. In regards to the recitation "capable of fixing the mercury contained in the burner in $\leq$ 2 seconds", it has been held that the recitation of an element being capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, Kawashima states that the mercury absorbing/adsorbing and/or blocking means is implemented "immediately" (for example, see paragraphs 0018 and 0028).

Regarding claim 9, Kawashima teaches the lighting device according to claim 1, wherein the at least one mercury absorbing/adsorbing and/or blocking means comprises a mercury absorbing/adsorbing means and a mercury blocking means, which are provided in such a way that mercury that will leave the burner after an explosion of the lamp will pass both the mercury absorbing/adsorbing means and the mercury blocking means before leaving the lighting device (for example, see paragraphs 0021-0031).

Regarding claim 10, Kawashima teaches a system comprising a lighting device according to claim 1, the system being a shop lighting system and/or, home lighting system

and/or, head lamp system and/or accent lighting system and/or, spot lighting system and/or, theater lighting system and/or, consumer TV application system and/or, fiber-optics application system, and/or image projection system (for example, see paragraph 0001).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Anthony Perry* whose telephone number is **(571) 272-2459**. The examiner can normally be reached between the hours of 9:00AM to 5:30PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-2457. **The fax phone number for this Group is (571) 273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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